

REMARKS

Claims 25-54 and new claims 62-63 are pending in this application. Applicants have cancelled claims 55-62, which were withdrawn from consideration by the Examiner as non-elected subject matter. Claims 1-24 were previously cancelled.

The Office Action has asserted one of the following rejections against claims 25-54: non-statutory obviousness-type double patenting, lack of enablement and/or indefiniteness.

Non-Statutory Double Patenting Rejection

Claims 25-28 have been rejected on the ground of non-statutory obviousness-type double patenting as purportedly being unpatentable over claims 20-24 in co-pending U.S. Patent Application No. 10/532,320 ("the '320 Application").

Applicants respectfully traverse this rejection as pre-mature and citing an application that was filed after the instant application. Since claims 20-24 in the '320 Application have not been allowed, this rejection is premature, and should be a provisional double patenting rejection, at most. As of the date of this Amendment, claims 20-24 in the '320 Application have not been allowed. Furthermore, the '320 Application has an October 23, 2002 priority date, whereas the instant application has a July 12, 2002 priority date. A non-statutory obviousness-type double patenting rejection is not applicable to an application with an earlier filing date because a terminal disclaimer in the instant application would not disclaim any of the patent term.

For these reasons, Applicants respectfully request that this rejection be reconsidered and withdrawn.

Rejection under 35 U.S.C. § 112, First Paragraph

Claims 24-44 have been rejected under 35 U.S.C. § 112, first paragraph, as purportedly not enabling a skilled artisan to make or use the claimed invention. Particularly, the Office Action contends that the Specification does not enable a skilled artisan to prophylactically treat an estrogen-sensitive tumor.

Notwithstanding the traversal asserted in the Request for Consideration submitted on

September 2, 2008, Applicants have amended claims 25 and 35 to replace “prophylactically treating” with “reducing the risk of developing”. Support for these amendments can be found in the specification at, for example, page 4, lines 19 to page 5, line 9; and page 10, lines 13-20.

Rejection under 35 U.S.C. § 112, Second Paragraph

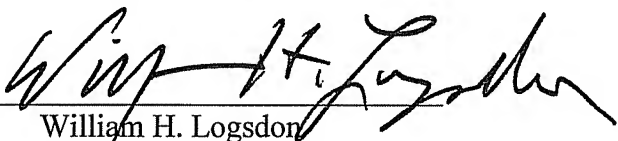
Claim 34 has been rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicants have adopted the Examiner’s suggestion and amended the claim to recite “further comprising”.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that all pending claims in the instant application are patentable over the cited prior art and are in condition for allowance. Accordingly, reconsideration and withdrawal of the asserted rejections and a Notice of Allowance are respectfully requested. Should the Examiner have any questions or concerns, the Examiner is invited to contact Applicants’ undersigned attorney by telephone at 412-471-8815.

Respectfully submitted,

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